

REMARKS

Please reconsider the application in view of the following remarks. Applicant thanks the Examiner for carefully considering this application.

Disposition of Claims

Claims 1-17 are currently pending in this application. Claims 1, 7, and 12 are independent. The remaining claims depend, directly or indirectly, from claims 1, 7, and 12.

Rejection(s) under 35 U.S.C. § 103

Claims 1-3 and 5-17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Publication No. 2002/0087628 (“Rouse”) in view of U.S. Patent No. 6,957,251 (“Wisner”) and further in view of U.S. Patent No. 6,807,559 (“Budhiraja”). This rejection is respectfully traversed.

To establish a *prima facie* case of obviousness “...the prior art reference (or references when combined) must teach or suggest all the claim limitations.” (See MPEP §2143.03). Further, “all words in a claim must be considered in judging the patentability of that claim against the prior art.” (See MPEP §2143.03). The Applicant respectfully asserts that the references, when combined, fail to teach or suggest all the claim limitations of the independent claims.

Turning to the rejection of the claims, the Examiner admits that Rouse fails to disclose or suggest:

- i) a plurality of tags contained within the JSP; and

- ii) using the plurality of tags to access a server providing the mail functions, as recited in independent claims 1 and 12 (*see* Office Action mailed May 19, 2006, page 3).

Applicant notes and appreciates that the Examiner found the previous arguments regarding Rouse persuasive. However, it appears that the Examiner may still be relying in part on Rouse to disclose JSPs. Thus, Applicant would like to reiterate that Rouse fails to disclose or suggest JSPs. The Examiner's attempt to equate the content pages disclosed by Rouse to the Java Server Page (JSP) recited in the claims requires the Examiner to improperly read out an express limitation of the claims. If the Applicant had intended for the claim scope to be broad enough to include the content page taught by Rouse, the Applicant would have merely claimed a server page. Instead, the Applicant's recited claims include a specific type of page, namely a "Java Server Page," which is a well known type of server page with particular advantageous functionality to those skilled in the art. Accordingly, this express limitation should not be improperly read out of the claim by the Examiner.

Wisner and Budhiraja fail to provide that which Rouse lacks. The Examiner relies on Wisner for disclosing tags within the JSP that are used to access a server providing mail functionality to clients. Applicant notes that it is unclear from the Office Action whether the Examiner is relying on Wisner or Rouse to disclose JSPs. However, for the reasons described above with respect to Rouse and below with respect to Wisner, neither Rouse nor Wisner disclose JSPs as recited in the present invention. The cited portion of Wisner discloses a 3-tier data center, where the first tier includes web servers that provide the presentation of the data center to users via static web pages. The second tier includes application servers that perform data processing (business logic), and the third tier includes database server that handle the

storage and retrieval of information (*see* Wisner, col. 4, ll. 16-31). Wisner only discloses that the second tier, *i.e.*, the application servers, may use a Java platform that supports JSPs and JVMs (Java Virtual Machines) (*see* Wisner, col. 5, ll. 1-5). Wisner does not disclose or suggest anything about accessing tags within JSPs, processing JSPs, or transmitting JSPs to users. Wisner fails to teach or suggest that *tags contained within JSPs* are used to access a server providing *mail functions* to a user. In fact, Wisner does not even mention the phrase “JSP tags” or “tags.”

Lastly, the Examiner asserts that Budhiraja discloses an HTML page that contains tags (*see* Office Action mailed May 19, 2006, page 4). Although the Examiner’s purpose in relying on Budhiraja is unclear, Applicant assumes that the Examiner is referring to the HTML pages of Budhiraja as being similar to the JSPs disclosed in the claimed invention. However, as explained in the previously filed arguments, an HTML page is completely distinct from a JSP. HTML pages do not contain *Java™ embedded code*. In fact, an HTML page cannot, by definition, be a JSP. They are two completely different ways for displaying dynamic content on a Web page. Furthermore, Budhiraja is completely silent with respect to the tags within the HTML page being used to access servers that provide *mail functionality*, as recited in the claims of the present invention.

Further, that there is no motivation to combine the teachings of Rouse, Wisner, and Budhiraja. Applicant notes that the Examiner attempts to provide motivation to combine Rouse, Wisner, and Budhiraja on page 4 of the Office Action mailed May 19, 2006. However, Applicant does not agree that the providing HTML pages from compiled applet classes with the Rouse-Wisner system for providing a more effective communication system is sufficient motivation to combine the prior art references: The Examiner cannot combine prior art

references to render a claimed invention obvious by merely showing that all the limitations of the claimed invention can be found in the prior art references. Instead, there must a suggestion or motivation to combine the references within the prior art references themselves. In other words, regardless of whether prior art references can be combined, there must an indication within the prior art references *expressing desirability* to combine the references. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990) (emphasis added).

Specifically, the prior art references are not related to each other. Rouse relates to providing mail services to clients using content pages. Wisner relates to providing network services using redundant resources. Particularly, Wisner discloses that in the event of a partial or complete failure of data center resources, a group of standby resources are activated and used to service user requests in place of the active resources (*see* Wisner, Abstract). That is, Wisner is concerned with how to continue network services provided to data centers when active resources of the data centers fail or no longer operate. Wisner has nothing to do with providing mail functionality. In contrast to both Rouse and Wisner, Budhiraja discloses managing applets. Applets are small programs embedded within HTML pages that are used to display graphics, animation, and/or moving text (*see* http://www.google.com/search?hl=en&lr=&defl=en&q=define:Applet&sa=X&oi=glossary_definition&ct=title, defining the term “applet”). Again, Budhiraja does not mention providing mail functionality nor does Budhiraja have anything to do with accessing tags within JSPs to provide mail functions to users. Applicant fails to see the relevance of Budhiraja in rejecting the claims of the present invention, and more importantly, fails to see how one skilled in the art would turn to the combination of Wisner and Budhiraja to achieve the present invention. Applet management is completely unrelated to providing network services and/or providing mail functionality to clients

using JSPs. Thus, one skilled in the art would not combine the teachings of Budhiraja with that of Rouse or Wisner to achieve the present invention.

In view of the above, it is clear that independent claims 1 and 12 are patentable over Rouse, Wisner, and Budhiraja, whether considered separately or in combination. Dependent claims 2, 3, 5, 6, and 13-17 are patentable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

With respect to independent claim 7, Applicant notes that the Examiner has not properly rejected independent claim 7. Independent claim 7 relates to a method for generating an extended Java server page for providing mail functions. Thus, claim 7 is directed toward generating a JSP, not simply using a JSP to provide mail functions. The Examiner has rejected claim 7 for the same reasons as claims 1 and 12, without taking into consideration that claim 7 does not recite the same subject matter as independent claims 1 and 12. In addition to the arguments made above, Applicant respectfully notes that none of the cited prior art references disclose anything related to the generation of JSPs for providing mail functions. Accordingly, favorable consideration of claims 7-11 is respectfully requested.

Claim 4, which depends from claim 1, stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Rouse, Wisner, Budhiraja, and U.S. Patent No. 5,948,058 ("Kudoh"). This rejection is respectfully traversed.

As described above, none of Rouse, Wisner, and Budhiraja disclose the limitations of claim 1. Further, Kudoh fails to provide that which Rouse, Wisner, and Budhiraja lack, as evidenced by the fact that the Examiner relies on Kudoh solely for the purpose of teaching

extending mail functions by adding the extended tags corresponding to new mail functionality of the mail server (*see* Office Action mailed May 19, 2006, page 7).

Further, Applicant notes that the Examiner has used a combination of four references to reject dependent claim 4 under 35 U.S.C. § 103(a). The purported reconstruction of the claimed invention by reliance on such a large number of references including, for example, a reference directed toward applet management, which has nothing to do with providing mail functions to clients using JSPs, is not appropriate. There is no suggestion or motivation that would enable one skilled in the art to turn to this combination of references to achieve the claimed invention. It is abundantly clear that the Examiner, using the present application as a guide, has selected isolated features of the various relied-upon references to arrive at the limitations of the claimed invention. Use of the present application as a "road map" for selecting and combining prior art disclosures is wholly improper. *See* MPEP § 2143; *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132 (Fed. Cir. 1985) (stating that "[t]he invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time"); *In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992) (stating that "it is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious This court has previously stated that 'one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.'"); *In re Wesslau*, 353 F.2d 238 (C.C.P.A. 1965) (stating that "it is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art") (*see also, Ex parte Lee Evan Nakamura*, et al, Appeal No. 2004-2245 (2005), which

states that using four or more references to reject narrow claims with a small number of limitations is suspect).

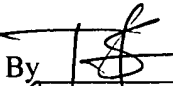
In view of the above, it is clear that independent claim 1 is patentable over Rouse, Wisner, Budhiraja, and Kudoh, whether considered separately or in combination. Dependent claim 4 is patentable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Conclusion

Applicant believes this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 03226/440001; P6490).

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Respectfully submitted,

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